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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79130324
Applicant	Les Amis Holdings Pte. Ltd.
Applied for Mark	NAMNAM NOODLE BAR
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Applicant Name: Les Amis Holdings Pte. Ltd.



Mark:

Serial No. **79130324**

Examining Attorney: Morgan L. Meyers

Law Office 117

APPEAL BRIEF OF APPLICANT

Pursuant to the Notice of Appeal filed on March 10, 2015, Applicant has appealed the Trademark Examining Attorney's FINAL refusal to register the applied-for mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the basis that there is a likelihood of confusion with the mark set forth in U.S. trademark registration no. 4463559. This is the sole issue on appeal.

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FACTS

Application has requested an extension of protection of its international registration, no.



1160699, seeking to register the mark for (currently) “services for providing food and drink; provision of restaurants, cafes, cafeterias and takeaway food and drink services; hospitality services, namely, providing food, drink and temporary accommodation; reservation of meals; catering services for food and drink; arranging of wedding reception food and drink; provision of food at social clubs; provision of cocktail lounge, bar, coffee bar, snack bar, wine bar, bistro; wine bar services; providing facilities, in the nature of provision of temporary accommodation, food and drink, for conventions, banquets, social functions, fund raising, and special events; rental of meeting rooms; rental of chairs, tables, table linen, glassware for meetings, conventions, conferences, exhibitions; provision of information about services for providing food, drink and temporary accommodation via all means of communication, including online from a computer database or the global communications network; provision of information, advisory and consultancy services in respect of all of the aforesaid services” in International Class 43.

On June 20, 2013, the Examining Attorney issued an Office Action provisionally refusing registration based on prior pending application serial no. 85692227. The Office Action also required a disclaimer of NOODLE BAR, required a translation of NAM and required that the recitation of services be amended.

On December 9, 2013, Applicant filed a response addressing the issues raised in the initial Office Action.

On January 4, 2014, the Examining Attorney issued a Suspension Notice suspending the instant application pending the final disposition of the cited application. Although the Suspension Notice does not explicitly state that Applicant's response resolved the other issues raised in the initial Office Action, the disclaimer, specification and translation requirements were not mentioned in subsequent Office Actions.

On January 7, 2014, the prior pending application issued as U.S. trademark registration no. 4463559 for the standard character mark NAM NOODLES AND MORE for "restaurant and catering services" in International Class 43.

On February 9, 2014, Applicant submitted a response requesting that prosecution of the instant application be resumed following the final disposition of the cited prior pending application.

On March 19, 2014, the Examining Attorney issued an Office Action refusing registration of the applied-for mark under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the mark set forth in U.S. trademark registration no. 4463559.

On August 25, 2014, Applicant submitted a response arguing that there is no likelihood of confusion.

On September 17, 2014, the Examining Attorney issued a FINAL Office Action refusing registration under Section 2(d).

On March 12, 2015, Applicant timely submitted a Notice of Appeal to the Trademark Trial and Appeal Board ("Board").

RECORD

The record consists of the following evidence made of record with the June 20, 2013 Office Action:

- (1) the instant application;
- (2) a print-out of the definition of “noodle” from <http://www.collinsdictionary.com>;
- (3) a print-out of the definition of “bar” from <http://education.yahoo.com>;
- (4) a print-out from Google Translate showing that “man” is an English translation of a Vietnamese term as “nam”;
- (5) a print-out from the US PTO’s X-Search database of United States trademark application serial no. 85692227.

The record also consists of the following evidence made of record with the March 19, 2014 Office Action:

- (6) a print-out from the US PTO’s X-Search database of United States trademark registration no. 4463559;
- (7) a print-out of a web page from the web site <http://www1.beyondmenu.com> showing a menu for a restaurant identified as NAM NOODLES & MORE.

Lastly, the record includes the following evidence made of record with Applicant’s August 25, 2014 response:

- (8) print-outs from the United States Patent and Trademark Office’s TSDR database satisfying the requirements of 37 CFR § 2.122(d) for submitting a current status and title copy of United States trademark registrations, nos. 3615430 and 3883720, for the marks WINGS 'N MORE and JUICY BURGERS & MORE, respectively.

ARGUMENTS

The Examining Attorney has refused registration of the applied-for mark under Section 2(d) of the Trademark Act on the grounds that there is allegedly a likelihood of confusion with the standard character mark NAM NOODLES AND MORE set forth in registration no. 4463559

for “restaurant and catering services.” For the following reasons, Applicant disagrees that there is a likelihood of confusion and hereby requests that the refusal be reversed.

The determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 65 USPQ2d 1201 (Fed. Cir. 2003).

Applicant and the Examining Attorney agree that the first factor of the *du Pont* test requires that the compared marks be viewed “in their entirety.” *See, e.g., Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *du Pont, supra* at 567. Moreover, it is a well-established rule that it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design. *In re Nat’l Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) (a likelihood of confusion “cannot be predicated on dissection of a mark, that is, on only part of a mark”).

The Examining Attorney argues that the compared marks are “substantially similar” on the basis that “the recognizable and dominant portion of applicant’s mark is the word ‘NAM’ which is identical to the recognizable and dominant portion of the registered mark.” September 17, 2014 Office Action, ¶ 7. Although the Examining Attorney argues that the term “NAM” in the registered mark cannot be ignored even though it has been disclaimed, the Examining Attorney completely ignores the design portion of the applied-for mark as well as the differences in the other verbal elements of the two marks. In so doing, the Examining Attorney makes no attempt to compare the marks in their entirety.

Applicant acknowledges that it is not improper to give more weight to a dominant feature of a mark in determining the commercial impression created by that mark provided the ultimate

conclusion rests on consideration of the marks in their entireties. *See In re Chatam Int'l Inc.*, 71 USPQ2d 1944 (Fed. Cir. 2004). It is, however, the Examining Attorney's burden to demonstrate which aspects of the marks consumers are most likely to remember. *See generally In re St. Helena Hosp.*, 113 USPQ2d 1082, 1084 (Fed. Cir. 2014) ("The PTO bears the burden of showing that a mark should not be registered."). In this case, the record is devoid of any evidence to support the Examining Attorney's assertion that "NAM" is the dominant element of either the registered mark or the applied-for mark. Instead, the evidence of record contradicts this assertion.

In support of her position that "NAM" is the dominant element of the registered mark, the Examining Attorney initially argued that it is "appropriate to give more weight to the 'NAM' portion of registrant's mark because of the descriptive nature of the wording 'NOODLES.'" March 19, 2014 Office Action, ¶ 10. Although Applicant agrees that non-distinctive wording is normally accorded less weight, this argument would support a finding that both NAM and NOODLES are less significant in creating the overall commercial impression of the registered mark and should be accorded less weight because both of those terms have been disclaimed in the registration. *See In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Therefore, the Examining Attorney's reasoning would instead support a finding that the wording AND MORE is the dominant element of the registered mark, as it is the only part of the registered mark that is not disclaimed. Moreover, the evidence of record (in the form of the third party registrations proffered by Applicant showing other marks registered for restaurant services that consist of descriptive wording and the equivalent of AND MORE) further demonstrates that AND MORE is considered distinctive with respect to restaurant services. As the distinctive

portion of the registered mark, AND MORE should be considered the dominant element of that mark. It certainly engenders the bulk of the commercial impression of the registered mark. Because this connotation is in no way suggested by the applied-for mark, the verbal elements of the compared marks have different connotations.

Although the Examining Attorney appears in the final Office Action to concede that NAM is not the dominant element of the registered mark because that term has been disclaimed, she continues to assert, solely based on the principle that disclaimed terms cannot be ignored, that the marks are “substantially similar” when viewed as a whole because “NAM” is “the recognizable and dominant portion of the registered mark.” September 17, 2014 Office Action, ¶¶ 7, 8. The Examining Attorney’s analysis, however, does not involve a comparison of the marks in their entireties nor does the Examining Attorney attempt to give any of the elements of the marks their proper weight. In fact, she does not give any weight to, or even take into consideration, the elements comprising either mark aside from the term NAM. These other elements are significant in creating the overall commercial impressions of the marks at issue.

The Examining Attorney ignores the fact that the dominant verbal element of the applied-for mark is not simply the term “Nam” but is instead “NamNam.” This readily distinguishes the applied-for mark from the registered mark. All of the words in the registered mark NAM NOODLES AND MORE would be vocalized by consumers not merely the wording NAM; while the applied-for mark would be vocalized (even assuming the design portion is not vocalized in any way) as “NamNam Noodle Bar” or possibly as “NamNam.” Taking into consideration either vocalization of the applied-for mark, it is clear that the literal elements of the marks, when compared in their entireties, are very different in sound.

The Examining Attorney’s analysis also does not take into account the highly distinctive design elements of the applied-for mark. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“The marks are considered in their entirety, words and design.”). There is no general rule that the literal portion of a mark will form the dominant portion of a composite mark. *See In re Electrolyte Labs., Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). In *Electrolyte Labs*, the Federal Circuit concluded that “the TTAB erred in its dominant focus on the K+ in both marks, to the substantial exclusion of the other elements of both marks.” The marks at issue were




both for supplements. On the basis that K+ is the symbol of the potassium ion and EFF is an abbreviation of “effervescent,” the court found no likelihood of confusion when the marks are viewed as a whole because the marks are not identical when pronounced and because the design of the marks is substantially different.

In numerous cases such as this, the Board and its reviewing courts have found that a prominent design can differentiate a standard character mark from a composite mark with the same or similar wording.

In *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009), the Board found no likelihood of confusion between applicant’s standard character mark VOLTA for



caffeine-infused vodka and the cited mark  for wines due to the “prominent design feature” and other wording in the mark.

In *Ferro Corp. v. Ronco Labs., Inc.*, 148 USPQ 497 (CCPA 1966), the CCPA found no



likelihood of confusion between applicant’s mark  and several marks owned by

opposer consisting of or containing FERRO, due to the dominance of the design elements of applicant's mark.

In *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007), the Board found



the prominently displayed design in the mark **BODYMAN** to be the dominant element of the mark because it catches the eye and engages the viewer before the viewer looks at the word "Bodyman". *Id.* at 1016. As a result, the Board found no likelihood of confusion with the registered standard character mark BOD MAN.

In *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987), the



Board found no likelihood of confusion between the mark for restaurant services and the registered standard character mark STEVE'S for ice cream. "Even with the word 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form." *Id.* at 1478-79.

In each of the cases discussed above, the compared marks consisted of wording and a separate design element. However, in the instant case, the literal elements of the applied-for mark are incorporated within the design element. In a case, similar to the instant case, involving wording incorporated into a design, the Board found no likelihood of confusion between the



applicant's mark and the registered standard character mark

RACEGIRL for legally identical goods (clothing). *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014).

In this case, Applicant's mark includes an intricate and detailed depiction of a person's head wearing a conical hat emblematic of Southeast Asia. The person is holding chopsticks and is eating from a large bowl. This design is positioned above and is visually more prominent than the literal portion of the mark. Applicant avers that the design portion of its mark is, therefore, equally as dominant as, if not more dominant than, the literal portion of its mark. Thus, it is clearly improper to ignore the design element of the applied-for mark when comparing the marks. Moreover, as in *Covalinski*, consumers, in the context of restaurant services, are likely to encounter the marks visually. Almost all restaurants display their marks on exterior signage outside of their establishments. Thus, visual dissimilarity is particularly important in the context of marks used in connection with restaurant services.

Only by either ignoring the non-common elements of the marks or improperly inflating the significance of the term NAM in the marks can it be concluded, as the Examining Attorney has done, that the compared marks are confusingly similar. Instead, Applicant avers that when proper weight and consideration are given to (1) the weakness of the common elements NAM and NOODLES, (2) the distinctive verbal element of the registered mark (3) the significant differences in the verbal elements of the two marks and, last but not least, (4) the dominance of the design element of the applied-for mark, the differences outweigh the similarities when the marks are compared in their entireties. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 110 (CCPA 1974) (confusion unlikely when marks or portions thereof are of such non-arbitrary nature that the public easily distinguishes even slight differences in the marks under consideration). Thus, the Examining Attorney's finding that the marks are "substantially similar" simply because they both include the term "NAM" is not supported by the relevant case law or the evidence of record. Because the marks engender different overall commercial

impressions, there is no likelihood of confusion. Applicant, therefore, respectfully requests that the likelihood of confusion refusal be reversed.

Respectfully submitted,

LES AMIS HOLDINGS PTE. LTD.

Dated: June 10, 2015

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